

REMARKS

Applicants note that all amendments, cancellations, and additions of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the cancelled claims (or similar claims) in the future.

In the office action dated 11/10/03, the Examiner made several objections to the specification and drawings. The Examiner states "The specification asserts that SEQ ID NO:1 and 33 differ in that SEQ ID NO:33 contains an insertion of a C at position 3020. However, the figures contains [sic] these sequences are both 4485 nucleotides in length." (Office Action, pg. 2). The Applicants respectfully disagree and direct the Examiner to Figure 11 (SEQ ID NO:33), and in particular to the line numbered 3180, which contains the inserted C at position 3124. Nonetheless, the Applicants have provided a substitute Figure 11 with corrected numbered attached hereto.

The Examiner further states "Upon close comparison of SEQ ID NO:1 and 33, the sequences appears [sic] to differ in an insertion of a C at location 3122 of SEQ ID NO:33. This does not appear to correspond to the specification which teaches a mutation at 3020...." Office Action, pg. 3. The applicants direct the Examiner to Figure 26, which indicates that the numbering designates the positions as reported by Ogura et al. (2001). The Applicants have utilized this nomenclature throughout the specification to refer to the mutation present in SEQ ID NO:33. The applicants submit that this nomenclature does not affect the clarity of the presently claimed invention.

In the office action dated 11/10/03, the Examiner made a number of rejections. The rejections are listed below in the order in which they are herein addressed.

- (1) Claim 34 stands rejected under 35 U.S.C. 112, first paragraph, as allegedly containing new matter;

¹ 65 Fed. Reg. 54603 (Sept., 8, 2000).

(2) Claims 1-9, 11-12, 24-31, 33, and 34-37 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly lacking written description; and

(3) Claims 1-9, 11-12, 24-31, 33, and 34-37 stand rejected under 35 U.S.C. 112, first paragraph as allegedly lacking enablement.

I. The Claims do not Contain New Matter

The Examiner has rejected Claim 34 under 35 U.S.C. 112, first paragraph, as allegedly containing new matter. In particular, the Examiner states "The concept of at least 33 c-terminal amino acids" does not appear to be part of the originally filed invention. Therefore, "at least 33 c-terminal amino acids" constitutes new matter." Office Action, pg. 4. The Applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have cancelled claim 34. As such, the rejection is moot.

II. The Claims are supported by a proper written description

The Examiner has rejected Claims 1-9, 11-12, 24-31, 33, and 34-37 as allegedly lacking written description. In particular, the Examiner states "There is not adequate description of the genus of variations within the scope of the claims." (Office Action, pg. 7). The Applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended independent Claims 1 and 24 and canceled Claims 34-37. The amended claims are directed towards uses of Nod2 variants having the specific cytosine insertion at position 3124 exemplified by SEQ ID NO:33. As the Examiner has admitted that "The specification teaches a significant association between Nod2 33, G908R, and R702W with Crohn's disease...." (Office Action, pg. 5), the Applicants respectfully request that the claims be passed to allowance.

III. The Claims are Enabled

The Examiner has rejected Claims 1-9, 11-12, 24-31, 33 and 34-37 as allegedly lacking enablement (Office Action, pg. 10). In particular, the Examiner states "Neither the art nor the specification enable the skilled artisan to make and use the claimed invention as broadly as claimed." Office Action, pg. 13. The Applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended independent Claims 1 and 24 and canceled Claims 34-37. The amended claims are directed towards Nod2 variants having the specific cytosine insertion at position 3124 exemplified by SEQ ID NO:33. As the Examiner has admitted that "The specification teaches a significant association between Nod2 33, G908R, and R702W with Crohn's disease...." (Office Action, pg. 11), the Applicants respectfully request that the claims be passed to allowance.

CONCLUSION

All grounds of rejection and objection of the Office Action of November 10, 2003 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the Claims should be allowed. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicant encourages the Examiner to call the undersigned collect at 608-218-6900.

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